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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,207	10/17/2001	Satoshi Hasegawa	01658/LH	5772

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EXAMINER

KANG, ROBERT N

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/981,207	Applicant(s) HASEGAWA, SATOSHI	
	Examiner Robert N. Kang	Art Unit 2622	<i>RNK</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment***Response to Arguments***

1. Examiner finds the arguments made by the applicant unpersuasive in overcoming the obviousness-type double patenting rejection. Applicant argues that new limitations added to claims 11 and 12, requiring a system and method "wherein a plurality of second logics are stored in a storage section in correspondence with respective count values, and if the second normal code (generated with one of the second logics) coincides with the response code from the consumable, the printing apparatus updates the count value stored in the storage section in correspondence with the second logic used to obtain the second normal code in accordance with usage of the consumable."

The original Hasegawa patent (US-PAT 6,597,875) has two sets of logic, one to distinguish if the consumable is unused, and one to distinguish if the consumable has been used, and therefore does not teach storing a plurality of second logics, each associated with a usage count for the consumable. As stated in the previous office action, this is an obvious modification of Hasegawa.

The new limitations, specifically pertaining to updating the count stored in the identifying apparatus, are not taught by either Hasegawa or Abe, but are expressly taught in US-PAT 6,672,695 B1 by Naka. This rejection is explained in detail under the Double Patenting rejection. Furthermore, because this new art was required only to meet the limitations required by the new matter added by the applicant, this rejection is deemed final.

Double Patenting

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2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, 9, and 11-15 of U.S. Patent No. 6,597,875 in view of Naka (US-PAT 6,672,695).

With regards to claim 11, limitations 1-6 (ending with "a change section") are clearly re-worded variations of claim 1 of the allowed Hasegawa patent, as detailed in the previous office action.

With regards to limitation 7, the Hasegawa patent does not disclose a "storage section which stores the second logic and an initial value as a count value corresponding to the second logic, said storage section being adapted to store a plurality of said second logics in respective correspondence with respective count values."

However, Naka discloses in column 4, lines 25-35, "the storage unit 110 of the host 100 stores host management data 29a, 29b,... for each cartridge, provided for the printer driver 7 to manage the cartridges separately. Each

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piece of the host management data 29a, 29b, ... includes ink total consumption amount,' 'cartridge identification information (for example, the serial manufacture number of the cartridge,' and 'cartridge history information.'" Therefore, it would have been obvious to modify the Hasegawa patent as taught by Naka such that the printer includes a unique identifier (second logic) for each print consumable cartridge, associated with a count for the given cartridge and stored in the storage of the identifying apparatus. Obviously, this modification of Hasegawa is utilized in the rejection of all following claim limitations.

Regarding limitation 8, requiring, "if the response code does not coincide with the first normal code, encoding section encodes the identification code with one said second logic stored in the storage section, and the collating section collates the second normal code with the response code." The Hasegawa encoder, as disclosed in column 4, lines 43-45, "includes a PLD (programmable logic device) and is capable of rewriting its internal logic by the control through the connector 29." Since the original, unmodified Hasegawa invention encodes and collates using the second logic if a match of the response code and first normal code is not in confidence, it is obvious that the modified Hasegawa invention would simply loop through all available second logics until a match is found, thereby also meeting the requirements for limitation 10.

With regards to limitation 9, Naka discloses in column 5, lines 51-55, "the host 100 first checks whether or not the 'cartridge identification information' recorded in the cartridge management data 25 received from the printer 500 matches the 'cartridge identification information' recorded in any of the host

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management data 29a, 29b, ... in the storage unit 110 at step S3-1.” This is congruous with the functionality of limitations 8 and 10. Furthermore, Naka discloses in column 5, line 62 to column 6, line 6, “If a match is found at step S3-1, a comparison is made between the ‘ink total consumption amount’ in the cartridge management data 25 and that in the corresponding host management data at step S3-3. If the comparison result indicates that the ink total consumption is greater than that in the host management data, it is determined that ... the ‘ink total consumption amount’ in the cartridge management data 25 is determined to be the precise value at step S3-8,” and the value at host 100 is consequently updated at S10. Therefore, the limitation “wherein if the second normal code coincides with the response code, an updating section of the printing apparatus updates the count value stored in the storage section in correspondence with the second logic used to obtain the second normal code in accordance with usage of the consumable,” as required by limitation 9.

In regards to limitation 11, the Hasegawa patent judges the consumable to be unusable if neither the first nor the second collation yields a match. Extrapolating to the modified Hasegawa invention, which has a plurality of second logics, it is quite obvious that if none of these match as well, the consumable is judged to be unusable.

Because the applicant’s invention describes an obvious modification of an earlier patent (Hasegawa), both the apparatus of claim 11 and the method of claim 12 are unpatentable over Hasegawa in view of Naka.

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Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

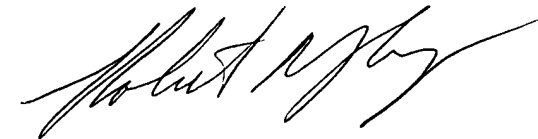
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert N. Kang whose telephone number is (571) 272-0593. The examiner can normally be reached on M-F 8-5.

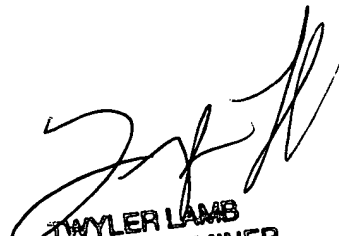
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RNK


TWYLER LAMB
PRIMARY EXAMINER